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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,005	02/20/2004	Herman John Thiele II		5419
<div>7590 Herman J. Thiele II 9918 Overton Road Burbank, OH 44214</div>				
			<div>EXAMINER WONG, STEVEN B</div>	
			<div>ART UNIT 3711</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 12/04/2007</div>	<div>DELIVERY MODE PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/782,005

Applicant(s)

THIELE, HERMAN JOHN

Examiner

Steven Wong

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The substitute specification filed March 21, 2006 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: it does not include a marked-up copy of the originally filed specification and a verified statement that it contains no new matter.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

I. The applicant is requested to note the following which is a format which may be used to transmit a letter to ratify a revision of the specification/claims/drawings:

I hereby ratify that the revision to the specification, claims, and/or drawings submitted on _____ for Serial # _____ contains no new matter.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of inventor _____

Inventor's signature _____ Date _____

1. A cursory review of the substitute specification filed March 21, 2006 reveals an objection under 35 U.S.C. 132(a) because it will introduce new matter into the disclosure. 35

U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. It is noted that the substitute specification appears to contain subject matter that is not fully supported by the originally filed specification. For example, the originally filed specification does not set forth a second process that secretes polyethylene for sealing a hole 1/64 inch in thickness, Rexine as a plastic for use in manufacturing the ball and a free floating object having the qualities of a light bulb.

Claim Objections

2. Claim 1 is objected to because of the following informalities: the status identifier "withdrawn" used to identify claim 1 is unclear. "Withdrawn" is usually reserved for withdrawing a claim from consideration due to a restriction/election requirement. It appears that applicant intends to cancel this claim from consideration and pursue new claims 2-5. It is noted

that claim 1 has not been considered and an action on the merits of claims 2-5 follows.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-5 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claims are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. Note the format of the claims in the patent(s) cited. In claim 2, the preamble of the claim is unclear in defining the scope of the invention. In claim 2, paragraph (b), the language "solid hollow" appears to be contradictory.

In claim 3, the claim is indefinite in setting forth any structure whatsoever for the sphere. The claim merely defines inherent properties of the sphere without setting forth any further structure.

In claim 4, the claim is indefinite in setting forth any structure whatsoever. The claim defines further properties that the plastic may possess, however, it does not positively claim these properties nor does it further define the plastic that would possess these properties.

In claim 5, the claim fails to positively define any structure for the sphere. The claim states properties that the sphere can possess, however, it does not positively recite these properties or any structure which would be capable of achieving these properties.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 2-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Terc (3,591,975). Insofar as claims 2-5 may be understood, Terc discloses the claimed structure.

Regarding claims 2, 3 and 5, Terc discloses a toy (12) that is filled with helium and balanced by weights so that the toy is substantially weightless. Note column 1, lines 1-15 and 40-45 and column 2, lines 1-10 and 17-42. Further, note column 2, lines 43-53 stating that the toy may be made from polyethylene which is considered to be a dense plastic. The limitation for the helium to be injected sealed with the same dense plastic is considered to be a product-by-process limitation. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Thus, because the final product of Terc is the same as that of applicant's claimed product, the claim is not patentable over Terc.

Regarding claim 4, the polyethylene plastic is seen as being nonporous and preventing the escape of helium from the sphere.

Response to Arguments

4. Applicant's arguments filed March 21, 2006 have been fully considered but they are not persuasive. Using the remarks directed to the Terc reference in the substitute specification filed March 21, 2006 as the basis for the applicant's arguments, the applicant contends that the

reference lacks the teaching for a specific amount of helium injected into the sphere and a specific overall weight for the sphere. Further, the applicant states that Terc does not disclose the use of blow molding the densest polyethylene that is available on the market at the time of the invention. However, these remarks are not persuasive as the instant claims fail to recite any of these specific differences. The instant claims merely recite a polyethylene body filled with helium. The reference to Terc teaches this arrangement. The instant claims fail to detail the amount or proportion of the helium therein or the particular density of the polyethylene that is to be used. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion


5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Steven Wong
Primary Examiner
Art Unit 3711

SBW
November 27, 2007